

REMARKS

This is in response to the Office Action dated July 23, 2010. To summarize, Claims 1, 2, 7, 17, 18, 23 and 24 are amended herein, and Claims 4 and 22 are cancelled.

Claims 1-9, 11-15 and 17-24 stand rejected under 35 USC §103 as unpatentable over Hayes (U.S. Patent No. 4 807 647) and Yoshida (U.S. Patent No. 6 206 007). Claim 1 now recites (inter alia) "a relatively high draw resistance downstream filtering plug having a tar retention from 35 to 45%" (this feature was contained in previously-pending Claim 4), and "the draw resistance of the downstream filtering plug being greater than the draw resistance of the upstream filtering plug". Hayes, as discussed in detail in the Request for Reconsideration filed May 19, 2010, teaches a downstream "second" core component 4 with a lower draw resistance than an upstream "first" core component 2, which is the opposite of the filter configuration recited in Claim 1. Additionally, Hayes teaches that this downstream "second" core component 4 has a tar retention of less than 30% at column 2, lines 49-55, and Table 2 in column 5 gives two examples of tar retention of core component 4 as 27% and 29%. All of these tar retention values presented in Hayes are clearly outside the claimed tar retention range of Claim 1. Thus, the downstream core component 4 in Hayes fails have a greater draw resistance than the upstream core component 2, and this downstream component 4 additionally fails to have a tar retention of 35 to 45%. Further, Yoshida, while same does appear to teach a downstream filter element 14 having a greater air-permeation resistance than that of an upstream filter element 13, Yoshida, as understood, does not teach the tar retention range recited in Claim 1. Instead, Yoshida appears to be primarily concerned with air permeation resistance relative to performance.

Thus, while the combination of Hayes and Yoshida is believed improper since one would not modify Hayes as suggested by the Examiner for the reasons presented in the Request for Reconsideration dated May 19, 2010, even if (for

the sake of argument only) one were to modify Hayes in this manner, such a modification would still not result in a downstream filtering plug having a tar retention from 35 to 45%, since this tar retention range, as acknowledged by the Examiner on page 3 of the Office Action, is not taught in either reference.

With respect to the tar retention range now recited in Claim 1, the Examiner states (with regard to previously-pending Claim 4) that it is not inventive to discover the optimum or workable ranges by routine experimentation where the "general conditions" of a claim are disclosed in the prior art. It is submitted that Hayes does not disclose the "general conditions" of Claim 1. Specifically, Hayes does not merely mention a complete opposite filter configuration from that recited in Claim 1, but instead clearly emphasizes this particular filter configuration (see Request for Reconsideration dated May 19, 2010). As such, this emphasis must be wholly disregarded in order to modify Hayes in view of Yoshida, which is believed improper, and any teachings of Hayes must be taken within the context of a structure which is opposite to that of Claim 1. Additionally, while Hayes does mention tar retention values for the downstream core component 4, such values are outside the range recited in Claim 1, and Hayes clearly states that tar retention values of less than 30% would be preferred. Thus, it is submitted that Hayes does not at all disclose the "general conditions" of Claim 1, and actually teaches away from the invention recited in Claim 1 with respect to: 1) a downstream filtering plug having a greater draw resistance than an upstream filtering plug; and 2) a downstream filtering plug having a tar retention from 35 to 45%. Yoshida does teach that the downstream filter element 14 has a greater air-permeation resistance than that of the upstream filter element 13. However, there is no reason to modify Hayes in view of Yoshida even in view of this teaching in Yoshida, as doing so requires one to disregard specific teachings in Hayes. Further, even if one were to combine the

two references, since neither reference teaches the tar retention range in Claim 1, the instant invention would not result.

Since Hayes does not even disclose the "general conditions" of Claim 1 as discussed above and actually teaches away from the tar retention range for the downstream filtering plug as recited in Claim 1, discovery of this tar retention range would not result from "routine experimentation". In this regard, if such a tar retention range would result from routine experimentation, then one would expect that this tar retention range would be taught in the prior art, and neither Hayes nor Yoshida teaches this range. Further, conceiving the use of the tar retention range recited in Claim 1 in an exact opposite structure from that of Claim 1 as taught in Hayes is more than "routine experimentation". Still further, as shown in the Table on page 17 of the instant specification in Examples 2 and 3 and as discussed on page 15 of the specification (last paragraph), a cigarette which incorporates the filter defined in Claim 1 advantageously provides low CO delivery (4.2 or 1.7 mg/cig compared to approximately 6.1 mg/cig for the prior art filter (labeled "Commercial")), and a low CO/tar delivery ratio (0.52 or 0.40 compared to 0.98 for the prior art filter). This is a remarkable improvement over the prior art which could not have been expected. Thus, this improvement on the prior art filters is a result of more than "routine experimentation".

In view of the above, Claim 1 is believed allowable over Hayes and Yoshida. Claims 2, 3, 5-9 and 19-21 depend on what is believed to be an allowable Claim 1, are believed allowable therewith, and include additional features which further distinguish over Hayes and Yoshida.

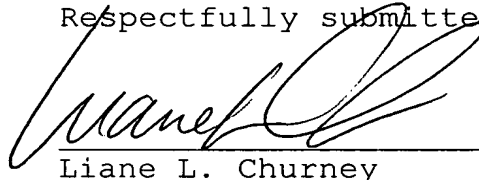
Independent Claims 17 and 18 are directed to a filter cigarette and a multiple length filter rod, respectively, and recite the features of the filter recited in Claim 1. Therefore, Claims 17 and 18 are believed allowable over Hayes for the same reasons as presented above with respect to Claim

1. Claims 23 and 24 depend from what is believed to be allowable Claims 17 and 18, respectively, are believed allowable therewith, and include additional features which further distinguish over Hayes and Yoshida.

Claims 15 and 18 stand rejected under 35 USC §103 as unpatentable over Hayes '647, Yoshida '007 and Banerjee (U.S. Patent No. 5 839 449). Claim 15 depends upon what is believed to be an allowable Claim 17, and as such, is believed allowable therewith. Further, Claim 18 is directed to a multiple length filter rod comprising a filter including the features of the filter recited in Claim 1. Since neither Yoshida nor Banerjee cures the deficiencies of Hayes as discussed above relative to Claim 1, Claim 18 is believed allowable for similar reasons as presented above relative to Claim 1.

In view of the above, reconsideration and allowance of the instant application are requested.

Respectfully submitted,



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